



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,344	07/06/2001	Craig S. Caldwell	30905	4930

30734 7590 02/04/2003

BAKER + HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

EXAMINER

SAVAGE, MATTHEW O

ART UNIT	PAPER NUMBER
----------	--------------

1723

6

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,344

Applicant(s)

CALDWELL ET AL.

Examiner

Matthew O Savage

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6, 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Applicant's election with traverse of species 1 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the examiner has not provided reasons as to why the examination of species is a serious burden. This is not found persuasive because examination of three patently distinct species in a single application would require three separate searches and examinations and therefor impose a serious burden upon the examiner.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Concerning the last two lines of claims 1 and 7, it is unclear as to what structural arrangement "wherein the return side filter and the supply side filter share a common housing component."

Regarding claims 2 and 8, it is unclear as to what particle size "relatively small particulates" implies.

As to claims 3 and 9, it is unclear as to what particle size "relatively large particulates" implies.

Concerning claims 4 and 10, it is uncertain as to what structure the term "bottom" implies.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Connor.

With respect to claim 1, O'Connor discloses a filtration assembly (see the drawing Figure) including a return-side filter 7 including a return side inlet, a return side outlet, and a return side filter media interposed between the return side inlet and outlet, a supply side filter 11 including a supply side inlet and a supply side outlet and a supply side filter media interposed between the supply side inlet and outlet, the return side filter and the supply side filter sharing a common housing component (e.g., the reservoir 5).

Concerning claim 2, O'Connor discloses the return filter side media as being operable to filter relatively small particles from the return fluid since it is associated with the "fine return filter 7".

As to claim 3, O'Connor discloses the supply side filter media as being operable to filter only relatively large particulates from the supply since it is associated with the "coarse suction filter 11".

Concerning claim 4, O'Connor discloses the common housing component as being a bottom since it is a reservoir which includes a bottom surface.

Art Unit: 1723

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor in view of Agner.

With respect to claim 7, O'Connor discloses a vehicle transmission with a fluid circulating therethrough, a sump 5 operable to receive fluid via a sump inlet 9, provide a reservoir for the fluid, and release fluid through a sump outlet 10, a filtration system including a return-side filter 7 including a return side inlet coupled to the sump inlet, a return side outlet, and a return side filter media interposed between the return side inlet and outlet, a supply side filter 11 including a supply side inlet and a supply side outlet coupled to the sump outlet, and a supply side filter media interposed between the supply side inlet and outlet, the return side filter and the supply side filter sharing a common housing component (e.g., the reservoir 5). O'Connor fails to specify the filtration assembly as being located within the sump. Agner discloses that it is known to dispose a filter assembly 1 in the sump 3 of a vehicle and suggests that such an arrangement conserves space. It would have been obvious to have modified the apparatus of O'Connor so as to have included the filter assembly within the sump as suggested by Agner in order to conserve space by locating the filters within the oil containing area of the sump as opposed to locating the filters externally of the transmission.

Concerning claim 8, O'Connor discloses the return filter side media as being operable to filter relatively small particles from the return fluid since it is associated with the "fine return filter 7".

As to claim 9, O'Connor discloses the supply side filter media as being operable to filter only relatively large particulates from the supply since it is associated with the "coarse suction filter 11".

Concerning claim 10, O'Connor discloses the common housing component as being a bottom since it is a reservoir which includes a bottom surface.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 6:00am-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1723

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. Savage

Matthew O Savage
Primary Examiner
Art Unit 1723

mos
January 24, 2003